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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/848,846 | 05/03/2001 | Luan C. Tran | MI22-1689 | 1789 |

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SPOKANE, WA 99201

EXAMINER

SCHILLINGER, LAURA M

ART UNIT PAPER NUMBER

2813

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,846

Applicant(s)

TRAN, LUAN C.

Examiner

Laura M Schillinger

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

This Office Action is in response to Amendment D, dated 6/30/03, in Paper No. 11.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 11-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-36 of prior issued Application No. 09/388856, currently claims 1-18 of US 6579751. Although the conflicting claims are not identical, they are not patentably distinct from each other because dependent claims 11-15 in combination with independent claim 5 are obvious in view of claim 18 et seq in the previously issued application. Applicant used the term "partially masked" in the issued claim 18, whereas in the current application applicant claims masking only "portions" of some of the devices. "Partially masked" and "masking portions" are obvious variations to one of ordinary skill in the art because they both imply an incomplete masking. Further it would have been obvious to one of ordinary skill in the art that the claim term "devices" would include n-type devices as claimed by the Applicant. Lastly, it would have been obvious to one of ordinary skill in the art to that the

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claim term transistor would include “field effect transistors” as claimed. Consequently, claims 11-15 are rejected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennison ('449).

In reference to claim 5, Dennison teaches a method comprising:

A masking step providing a common mask (Fig.2 (38)); and

An implant step carried through the common mask, comprising conducting a halo implant of devices formed over a substrate comprising memory circuitry and peripheral circuitry sufficient to impart to at least two of the devices two different respective threshold voltages (Col.2, lines: 50-65, see also Fig.2 ((26), (18), and (22)).

However, Dennison fails to teach “at least three of the devices having three different threshold voltages. However, the courts have held that mere duplication of parts has no

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patentable significance unless a new or unexpected result is produced see *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Since Applicant is merely adding an additional transistor, Applicant is merely reciting a duplication of parts to produce an expected result. Consequently, Applicant's claim is rejected as being obvious over Dennison.

In reference to claim 6, Dennison teaches wherein the three devices comprise peripheral circuitry (Fig.2 (26 and 22) see also Col.3, lines: 10-20).

In reference to claim 7, Dennison teaches wherein the three devices comprise NMOSFETs (Fig.2 (16 and 24) see also Col.3, lines: 10-20).

In reference to claim 8, Dennison teaches wherein the three devices comprise NMOSFETS comprising peripheral circuitry (Fig.2 (24, peripheral areas are (26) see also Col.3, lines: 10-20).

In reference to claim 9, Dennison teaches wherein the three devices comprise PMOSFETs (Fig.2 (16) see also Col.3, lines: 10-20).

In reference to claim 10, Dennison teaches wherein the three devices comprise a MOSFET comprising peripheral circuitry (Fig.3 (22) see also Col.3, lines: 60-65).

Response to Arguments

Applicant's arguments filed have been fully considered but they are not persuasive. Applicant argues that the Examiner's double patenting rejection was improper however, as explained above the differences in Applicant's claim language are merely obvious variations. Applicant further argues that the Examiner's rejection of claims 5-10 was improper on the grounds that Dennison fails to teach 3 transistors, even if this were to be true, the courts have held that mere duplication of parts has no patentable significance unless a new or unexpected result is produced see *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). However, Applicant is mistaken, Dennison does teach 3 transistors, see Fig.s 1-5, see further Col.5, lines: 5-10.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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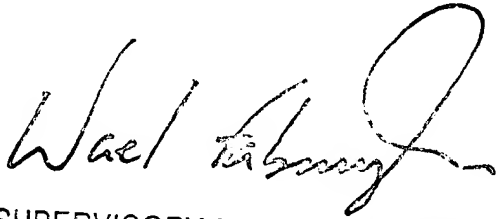
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura M Schillinger whose telephone number is (703) 308-6425. The examiner can normally be reached on M-T, R-F 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl W Whitehead, Jr. can be reached on (703) 308-4940. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

LMS

9/19/03


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